

CERTIFICATE UNDER 37 CFR § 1.10 OF MAILING BY "EXPRESS MAIL"

EV 901562228 US

October 3, 2006

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Date of Deposit

I hereby certify that this correspondence is being deposited with the United States Postal Services "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated above and is addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: _____

Sarah M. Barnett



PATENT

Customer No. 22,852

Attorney Docket No. 07579.0015-01000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Graham Edmund KELLY (as amended)

Application No.: 10/600,004

Filed: June 18, 2003

For: METHODS FOR BONE
TREATMENT USING
FORMONONETIN AND OTHER
ISOFLAVONES (as amended)

)
)
)
) Group Art Unit: 1614
)
) Examiner: Ardin H. MARSCHEL
)
) Confirmation No.: 6037
)
)
)

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESUBMISSION OF DOCUMENTS

**ORIGINALLY CITED IN MAY 16, 2006, INFORMATION DISCLOSURE STATEMENT
AND UPDATE OF CO-PENDING APPLICATION INFORMATION**

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(c), Applicant brings to the attention of the Examiner the documents listed on the enclosed IDS Form PTO/SB/08. This Information Disclosure Statement is being filed after the events recited in Section 1.97(b) but, to the undersigned's knowledge, before the mailing date of either a Final action, Quayle action, or a Notice of Allowance. Under the provisions of 37 C.F.R. § 1.97(c), a request to charge the fee of \$180.00 as specified by Section 1.17(p) is included in the Transmittal Letter filed herewith.

10/06/2006 CNGUYEN2 00000083 10600004

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Copies of the cited Office Actions in issued or co-pending patent applications are not enclosed because they are available on the USPTO Image File Wrapper System of PAIR.

The Office did not previously consider these references. Therefore, Applicant resubmits them herewith and respectfully requests the Examiner to consider these references in view of the holding in *Dayco Products, Inc. v. Total Containment, Inc.*

The United States Court of Appeals for the Federal Circuit held in *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 U.S.P.Q.2d 1801 (Fed. Cir. 2003), that an “adverse decision” by another examiner may meet the materiality standard under the amended Rule 56, and thus, applicants should disclose prior rejections of “substantially similar claim[s]” to the Office. Accordingly, although Applicant is not representing that the Office Actions in the co-pending applications are material to the present application and are not admitting that any of the other claims are substantially similar, out of an abundance of caution, Applicant has listed the substantive Office Actions filed in co-pending applications on the enclosed Form PTO/SB/08.

Applicant respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

Also as a courtesy to the Examiner, Applicant hereby updates the cross-reference table, previously submitted on December 13, 2004, with the patent and publication numbers for the following commonly assigned U.S. patents and co-pending U.S. patent publications:

US 2004/0170713 A1 to Kelly (published June 3, 2004);

US 2005/0036962 A1 to Kelly et al. (published February 17, 2005);

US 2005/0049424 A1 to Kelly et al. (published March 3, 2005)

US 2005/0059616 A1 to Kelly et al. (published March 17, 2005);

US 2005/0119301 A1 to Husband et al. (published June 2, 2005);

US 2005/0131047 A1 to Kelly et al. (published June 16, 2005);
US 2005/0143588 A1 to Heaton et al. (published June 30, 2005);
US 6,987,098 B2 to Kelly (issued January 17, 2006);
US 7,033,621 B1 to Kelly (issued April 25, 2006);
US 7,045,155 B2 to Kelly (issued May 16, 2006);
US 2006/0106220 A1 to Heaton et al. (published May 18, 2006);
US 2006/0167083 A1 to Kelly et al. (published July 27, 2006); and
US 2006/0217564 A1 to Heaton et al. (published September 28, 2006).

This resubmission does not represent that a search has been made or that better art exists. It does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claims in the application and Applicant determines that the cited documents do not constitute "prior art" under United States law, Applicant reserves the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

Applicant further reserves the right to take appropriate action to establish the patentability of the claimed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 3, 2006

By: Elisabeth Jaffe Barek
Elisabeth Jaffe Barek
Reg. No. 46,797
Customer No. 22,852

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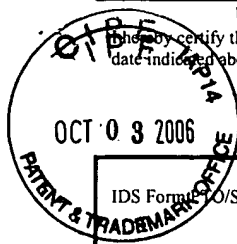
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By: _____

Sarah M. Barnett



IDS Form 10/08: Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet

1

of

2

Complete if Known

| | |
|-------------------------------|-------------------|
| <i>Application Number</i> | 10/600,004 |
| <i>Filing Date</i> | June 18, 2003 |
| <i>First Named Inventor</i> | Graham E. KELLY |
| <i>Art Unit</i> | 1614 |
| <i>Examiner Name</i> | Ardin H. MARSCHEL |
| <i>Attorney Docket Number</i> | 07579.0015-01000 |

U.S. PATENTS AND PUBLISHED U.S. PATENT APPLICATIONS

| Examiner Initials* | Cite No. | Document Number | Issue or Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------|----------|-----------------------------|---|---|---|
| | | Number-Kind Code (if known) | | | |
| | | | | | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | Translation |
|--------------------|----------|--|--------------------------------|---|---|-------------|
| | | Country Code Number Kind Code (if known) | | | | |
| | | | | | | |

NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | Translation |
|--------------------|----------|---|-------------|
| | | Office Action issued in U.S. Patent No. 6,340,703 on July 9, 1999 (Attorney Docket No. 07579.0006-00000). | |
| | | Office Action issued in U.S. Patent No. 6,340,703 on April 27, 2000 (Attorney Docket No. 07579.0006-00000). | |
| | | Amendment and Response filed in U.S. Patent No. 6,340,703 on October 27, 2000 (Attorney Docket No. 07579.0006-00000). | |
| | | Office Action issued in U.S. Patent No. 6,340,703 on February 9, 2001 (Attorney Docket No. 07579.0006-00000). | |
| | | Amendment filed in U.S. Patent No. 6,340,703 on May 31, 2001 (Attorney Docket No. 07579.0006-00000). | |
| | | Office Action issued in U.S. Patent Application No. 09/986,509 on July 23, 2002 (Attorney Docket No. 07579.0006-01000). | |
| | | Amendment filed in U.S. Patent Application No. 09/986,509 on December 23, 2002 (Attorney Docket No. 07579.0006-01000). | |
| | | Office Action issued in U.S. Patent Application No. 09/986,509 on February 6, 2004 (Attorney Docket No. 07579.0006-01000). | |
| | | Amendment and Response filed in U.S. Patent Application No. 09/986,509 on August 5, 2004 (Attorney Docket No. 07579.0006-01000). | |
| | | Office Action issued in U.S. Patent Application No. 09/986,509 on October 24, 2005 (Attorney Docket No. 07579.0006-01000). | |

Examiner
Signature

Date
Considered

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

| | | | | | |
|--|---|----|---|-------------------------------|-------------------|
| IDS Form PTO/SB/08: Substitute for form 1449A/PTO | | | | Complete if Known | |
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i> | | | | <i>Application Number</i> | 10/600,004 |
| | | | | <i>Filing Date</i> | June 18, 2003 |
| | | | | <i>First Named Inventor</i> | Graham E. KELLY |
| | | | | <i>Art Unit</i> | 1614 |
| | | | | <i>Examiner Name</i> | Ardin H. MARSCHEL |
| | | | | <i>Attorney Docket Number</i> | 07579.0015-01000 |
| Sheet | 2 | of | 2 | | |

| NON PATENT LITERATURE DOCUMENTS | | | |
|---------------------------------|--|---|--|
| | | Amendment and Response to Office Action filed in U.S. Patent Application No. 09/986,509 on April 24, 2006 (Attorney Docket No. 07579.0006-01000). | |
| | | Office Action issued in U.S. Patent Application No. 09/986,509 on July 11, 2006 (Attorney Docket No. 07579.0006-01000). | |
| | | Office Action issued in U.S. Patent No. 6,599,536 on October 23, 2001 (Attorney Docket No. 07579.0013-00000). | |
| | | Amendment filed in U.S. Patent No. 6,599,536 on March 25, 2002 (Attorney Docket No. 07579.0013-00000). | |
| | | Office Action issued in U.S. Patent No. 6,599,536 on June 18, 2002 (Attorney Docket No. 07579.0013-00000). | |
| | | Amendment and Response After Final filed in U.S. Patent No. 6,599,536 on December 17, 2002 (Attorney Docket No. 07579.0013-00000). | |
| | | Notice of Allowance with Statement of Reasons issued in U.S. Patent No. 6,599,536 on April 8, 2003 (Attorney Docket No. 07579.0013-00000). | |
| | | Preliminary Amendment filed in U.S. Patent Application No. 10/459,537 on June 12, 2003 (Attorney Docket No. 07579.0013-01000). | |
| | | Office Action mailed in U.S. Patent Application No. 10/459,537 on December 20, 2005 (Attorney Docket No. 07579.0013-01000). | |
| | | Amendment filed in U.S. Patent Application No. 10/459,537 on May 8, 2006 (Attorney Docket No. 07579.0013-01000). | |
| | | Advisory Action mailed in U.S. Patent Application No. 10/459,537 on July 20, 2006 (Atty. Docket No. 07579.0013-01000). | |
| | | Office Action mailed in U.S. Patent Application No. 09/914,035 on December 18, 2002 (Attorney Docket No. 07579.0015-00000). | |

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|-----------------------|--|--------------------|--|
| Examiner Signature | | Date Considered | |
|-----------------------|--|--------------------|--|

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.